## STIC-Biotech/ChemLib

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From:

STIC-ILL

Sent:

Monday, December 17, 2001 1:50 PM

To: Subject: STIC-Biotech/ChemLib RE: Litigation search

-----Original Message-----

From:

Johannsen, Diana

Sent:

Monday, December 17, 2001 1:46 PM

To:

STIC-ILL

Subject:

Litigation search

Could you please do a litigation search for US Patent 5,750,338 (reissue application 09/533,906)?

I was not sure where to email this request - could you please forward as appropriate?

Thanks very much.

#### Diana Johannsen

AU 1655 CM1, 12D03 Mailbox 12E12 703/305-0761

Point of Contact:

Mona Smith
Technical Info. Specialist
CM1 12C14 Tel: 308-3278

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Phone:
Location:
Date Picked Up: 12/10/01
Date Completed: 12/20/01
Searcher Prep/Review: <u>3</u>
Clerical:
Online time: 40

TYPE OF SEARCH:
NA Sequences:
AA Sequences:
Structures:
Bibliographic:
Litigation:
Full text:
Patent Family:
Other:

VENDOR/COST(w	vhere applic.)
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Questel/Orbit:	
DRLink:	
Lexis/Nexis:	
Sequence Sys.:	
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Other (specify):	

polynucleotide.

1/1 PLUSPAT - (C) QUESTEL-ORBIT- image PN - US5750338 A 19980512 [US5750338] TI - (A) Target and background capture methods with amplification for affinity assays PA - (A) AMOCO CORP (US) IN - (A) COLLINS MARK L (US); HALBERT DONALD N (US); KING WALTER (US); LAWRIE JONATHAN M (US) AP - US23808094 19940503 [1994US-0238080] PR - US12482693 19930921 [1993US-0124826] - US13692087 19871221 [1987US-0136920] - US23808094 19940503 [1994US-0238080] - US64846891 19910131 [1991US-0648468] - US92215586 19861023 [1986US-0922155] - US94674992 19920917 [1992US-0946749] IC - (A) C07H-021/04 C12P-019/34 C12Q-001/68 C12Q-001/70 EC - C12Q-001/68B - C12Q-001/68D4 ICO - M12Q-220/114 - M12Q-240/910 - S01N-035/00M PCL - ORIGINAL (O): 435006000; CROSS-REFERENCE (X): 435005000 435007100 435091200 435174000 536024300 536024320 536024330 DT - Basic CT - US4851331; US5200314; US5232829; EP0139489; EP0159719 STG - (A) United States patent

AB - A method of assay for target polynucleotides includes steps of isolating target polynucleotides from extraneous non-target polynucleotides, debris, and impurities and amplifying the target

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1...5...10...15...20...25...30...

Johannsen Patent 5,750,338

### LIBRARIES -- PAGE 1 of 3

Please TRANSMIT the NAME (only one) of the library you want to search.

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ADVSOR 6 CONLAW 8 ELDER 9 FEDTAX 10 K-LAW 11 PUBCON 12 TELCOM 10 GENMED 15
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Library: PATENT

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PATNO IS 5,750,338

If it is not what you intended to enter, please press the STOP key. <LEXIS is working on the displayed request.>

PATNO IS 5,750,338

Your search request has found 1 PATENT through Level 1. To DISPLAY this PATENT press either the KWIC, FULL, CITE or SEGMTS key. To MODIFY your search request, press the M key (for MODFY) and then the TRANSMIT key.

.se;lit-reex,reex-cert;disclaimer;reissue

LEVEL 1 - 1 OF 1 PATENT

<5,750,338>

### <=2>> GET 1st DRAWING SHEET OF 10

May 12, 1998

Target and background capture methods with amplification for affinity assays

CORE TERMS: sample, polynucieotide, bead, medium, capture, binding, moiety, retrievable, target, probe...

Please TRANSMIT the NAME of the file you want to search. To see a description of a file, type its page number and press the TRANSMIT key. File: CASES

PATNO IS 5,750,338

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5750338 OR 5,750,338

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File: NEWS

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### LEVEL 1 - 1 OF 4 STORIES

Copyright 2001 PR Newswire Association, Inc. PR Newswire

July 10, 2001, Tuesday

SECTION: FINANCIAL NEWS

DISTRIBUTION: TO BUSINESS, MEDICAL AND TECHNOLOGY EDITORS

LENGTH: 550 words

HEADLINE: Vysis Grants License to bioMerieux, Inc. Under Its Collins Patent; Technology Improves Sensitivity of DNA Probe Technology Using Amplification

DATELINE: DOWNERS GROVE, III., July 10

#### BODY:

... disease management, announced today that it has granted a nonexclusive license to bioMerieux, Inc. under its U.S. Patent No. <5,750,338> (the Collins patent) and related patents. The Collins patent relates to nucleic acid diagnostic methods utilizing target capture and in ...

## LEVEL 1 - 2 OF 4 STORIES

Copyright 2001 PR Newswire Association, Inc. PR Newswire

July 2, 2001, Monday

SECTION: FINANCIAL NEWS

DISTRIBUTION: TO BUSINESS AND MEDICAL EDITORS

LENGTH: 840 words

HEADLINE: Vysis to Seek Appeal of Interim Ruling in Patent Infringement Suit;

Firm Seeks Protection of Royalty Stream From Licensee

DATELINE: DOWNERS GROVE, III., July 2

BODY:

... summary judgment by Gen-Probe Incorporated, which claimed that Gen-Probe

does not infringe Vysis' U.S. Patent No. <5,750,338> (the Collins patent). Although the district court could modify its ruling prior to issuing a final judgment, Vysis plans to seek ...

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LEVEL 1 - 3 OF 4 STORIES

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CHEMICAL BUSINESS NEWSBASE

January 25, 2000

LENGTH: 283 words

HEADLINE: PRESS RELEASE: Vysis to defend patent licensed to Gen-Probe

BODY:

... District Court in San Diego, CA, seeking a declaration of invalidity and noninfringement of Vysis' US Patent No <5,750,338> for "Target and Background Capture Methods with Amplification for Affinity Assays," issued 12 May 1998 to M L ...

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LEVEL 1 - 4 OF 4 STORIES

Copyright 2000 PR Newswire Association, Inc. PR Newswire

## January 20, 2000, Thursday

**SECTION: FINANCIAL NEWS** 

**DISTRIBUTION: TO BUSINESS AND MEDICAL EDITORS** 

LENGTH: 968 words

HEADLINE: Vysis to Defend Patent Licensed to Gen-Probe

DATELINE: DOWNERS GROVE, III., Jan. 20

BODY:

... Court in San Diego, California, seeking a declaration of invalidity and non-infringement of Vysis' U.S. Patent No. <5,750,338> for 'Target and Background Capture Methods with Amplification for Affinity Assays," issued May 12, 1998 to M. L. ...

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## PR Newswire January 20, 2000, Thursday

No. <5,750,338> for "Target and Background Capture Methods with Amplification for Affinity Assays," issued May 12, 1998 to M. L. Collins et al. The Collins patent covers a method that enables substantial improvement in clinical sensitivity for enzyme amplification technologies, such as Gen-Probe's transcription mediated amplification (TMA) technology, and was licensed to Gen-Probe as part of a June 1999 settlement of patent litigation between Vysis and Gen-Probe. Gen-Probe's suit seeks to eliminate it's obligation to pay license royalties to Vysis on Gen-Probe's nucleic acid testing (NAT) test kits for HIV and HCV, currently in large scale clinical trials for blood screening and to be marketed by Chiron Pharmaceuticals. Even though it filed the suit, Gen-Probe has not terminated its license under the Collins patent. In addition, concurrently with filing the suit, Gen-Probe exercised options to extend its license under the patent to its partnerships with Chiron and Bayer. Vysis has not yet responded to the complaint but intends to defend its patent rights vigorously.

"In our view, this suit has been brought because the anticipated royalty payments to Vysis under the Collins license greatly exceed the cost of a lawsuit to try to invalidate the patent," stated John L. Bishop, Vysis president and CEO. "Although no one likes litigation, the significant technological advance of the Collins patent makes us confident of a favorable outcome."

The patented technology was invented in the mid-1980's and relates to

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# PR Newswire January 20, 2000, Thursday

pathogen detection methods that achieve high clinical sensitivity by coupling Vysis' reversible target capture technology with enzymatic nucleic acid amplification techniques, such as the polymerase chain reaction, Q-beta replicase, and transcription mediated amplification. The utility of the patented technology was proven by Vysis in clinical trials using an automated DNA probe testing instrument in 1994-95, as reported by Smith, et al. in the Journal of Clinical Microbiology Vol. 35, No. 6, June 1997 at 1477-83 and 1484-91, where use of the patented technology greatly improved the clinical sensitivity of the assay.

Chiron has announced that the clinical trials of the Gen-Probe NAT product currently encompass testing of approximately 70 percent of the U.S. blood supply, and financial analysts expect its FDA approval in mid-2000. "We are confident that our patent rights will be sustained and that Gen-Probe's HIV/HCV product will be found to infringe those rights," stated Norval B. Galloway, Vvsis patent counsel.

In November 1999, Vysis announced goals of achieving break-even status of its operations in the fourth quarter of 2000, and profitability for the full year 2001. "We have evaluated these goals in light of the litigation expense we estimate for this suit and we have decided not to adjust these goals. Vysis has recently significantly reduced its operating expenses in Europe by the appointments of exclusive distributors in France and Italy, and we believe

these reductions mitigate the financial impact from the expected cost of the suit," stated Bishop.

Vysis, Inc. of Downers Grove, Ill., is a genomic disease management company that develops, commercializes and markets clinical products providing information critical to the evaluation and management of cancer, prenatal disorders and other genetic diseases. The company has direct sales operations in the United States and Europe, a marketing partnership in Japan with Fujisawa Pharmaceutical Co., and a worldwide distribution network.

The statements in this press release concerning Vysis' future financial results as well as any other statements which are not historical facts, are forward-looking statements and are subject to risks and uncertainties inherent in the company's business. These risks and uncertainties, which could cause actual results to differ materially from those expressed or implied by the forward-looking statements, include: the market acceptance of the company's clinical products; the extent to which the clinicians or laboratories performing the procedures with the company's products are able to obtain third-party reimbursement; the ability of the company to successfully market and sell its clinical products, other products and equipment; competition; compliance by the company with regulatory requirements and the timely receipt of necessary

governmental approvals; the company's ability to manufacture products in sufficient quantities; the company's ability to maintain intellectual property protection for its proprietary products, to defend its existing intellectual property rights from challenges by third parties, and to avoid infringing intellectual property rights of third parties; and the company's cost control efforts. In addition, a detailed discussion of risks and uncertainties may be found in the company's periodic filings with the Securities and Exchange Commission. Vysis disclaims any intent or obligation to update these forward-looking statements.

To receive Vysis, Inc.'s latest news release and other corporate documents, free of charge via fax, simply dial 1-800-PRO-INFO. Use company ticker VYSI.

SOURCE Vysis, Inc.

CONTACT: John L. Bishop, President & CEO of Vysis, Inc., 630-271-7000; or General Info., Leslie Hunziker, 312-640-6760, Analysts, Suzy Olson, 312-274-2258, or Media, Darcy Bretz, 312-640-6756, all of The Financial Relations Board, for Vysis

URL: http://www.prnewswire.com

DATE: DECEMBER 20, 2001 CLIENT: JOHANNSEN

LIBRARY: NEWS FILE: CURNWS

Your search request is: 5750338 OR 5,750,338

Number of STORIES found with your search request through: LEVEL 1...

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PATENT FAMILY:
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    Patent Assignee: AMOCO CORP
                                 (US)
    Author (Inventor): COLLINS MARK LEO
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    Patent Assignee: AMOCO CORP
                                 (US)
            (Inventor): COLLINS MARK LEO (US); HALBERT DONALD NEIL (US);
   Author
      KING WALTER (US); LAWRIE JONATHAN MICHAEL (US)
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      (English)
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Patent Assignee: AMOCO CORP
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   Patent Assignee: AMOCO CORP
   Author (Inventor): COLLINS MARK LEO (US)
   Priority (No, Kind, Date): US 922155 A
                                            19861023
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19871023

Applic (No, Kind, Date): CN 87107800 A

#### GERMANY (DE)

Legal Status (No, Type, Date, Code, Text):

19921029 EP 265244 P

TRANSLATION OF PATENT 19930506 DE 8373 Ρ DE 3781860 DOCUMENT OF EUROPEAN PATENT RECEIVED (UEBERSETZUNG DER PATENTSCHRIFT DES

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   DE 3781860
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                             OPPOSITION (EINSPRUCHSFRIST ABGELAUFEN OHNE
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                       19951019 DE REF
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                             EP 328829 P ·19951019
   DE 3854470
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                             PATENTSCHRIFT DES EUROPAEISCHEN PATENTES IST
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                             DASS EINSPRUCH ERHOBEN WURDE)
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 Patent (No, Kind, Date): EP 265244 A2 19880427
   TARGET AND BACKGROUND CAPTURE METHODS AND APPARATUS FOR AFFINITY ASSAYS
      (English; French; German)
   Patent Assignee: AMOCO CORP
                                 (US)
   Author (Inventor): COLLINS MARK LEO
   Priority (No, Kind, Date): US 922155 A
                                            19861023
   Applic (No, Kind, Date): EP 87309308 A
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   Designated States: (National) AT; BE; CH; DE; ES; FR; GB; IT; LI; LU;
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   IPC: * G01N-033/538; C12Q-001/68; G01N-033/553; G01N-033/546
   CA Abstract No: ; 109(11)089343D
   Derwent WPI Acc No: ; C 88-114361
   Language of Document: English
 Patent (No, Kind, Date): EP 328829 A2
                                       19890823
   METHOD FOR AFFINITY ASSAYS USING TARGET AMPLIFICATION (English; French;
   Patent Assignee: AMOCO CORP (US)
   Author (Inventor): COLLINS MARK LEO; HALBERT DONALD NEIL; KING WALTER;
    LAWRIE JONATHAN MICHAEL
   Priority (No, Kind, Date): US 136920 A
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     C12N-015/00
   CA Abstract No: ; 113(11)094353U
   Derwent WPI Acc No: ; C 89-242804
   Language of Document: English
 Patent (No, Kind, Date): EP 265244 A3 19890510
   TARGET AND BACKGROUND CAPTURE METHODS AND APPARATUS FOR AFFINITY ASSAYS
      (English; French; German)
   Patent Assignee: AMOCO CORP
   Author (Inventor): COLLINS MARK LEO
   Priority (No, Kind, Date): US 922155 A
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   Derwent WPI Acc No: * C 88-114361
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   METHOD FOR AFFINITY ASSAYS USING TARGET AMPLIFICATION (English; French;
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   Author (Inventor): COLLINS MARK LEO; HALBERT DONALD NEIL; KING WALTER;
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    Language of Document: English
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    TARGET AND BACKGROUND CAPTURE METHODS AND APPARATUS FOR AFFINITY ASSAYS
      (English; French; German)
    Patent Assignee: AMOCO CORP
   Author (Inventor): COLLINS MARY LEO (US)
    Priority (No, Kind, Date): US 922155 A
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    Applic (No, Kind, Date): EP 87309308 A
                                            19871021
    Designated States: (National) AT; BE; CH; DE; ES; FR; GB; IT; LI; LU;
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    IPC: * G01N-033/543; C12Q-001/68
    CA Abstract No: * 109(11)089343D
    Derwent WPI Acc No: * C 88-114361
    Language of Document: English
  Patent (No, Kind, Date): EP 328829 B1 19950913
   METHOD FOR AFFINITY ASSAYS USING TARGET AMPLIFICATION. (English; French
      ; German)
    Patent Assignee: AMOCO CORP (US)
                                          (US); HALBERT DONALD NEIL (US);
    Author (Inventor): COLLINS MARK LEO
      KING WALTER (US); LAWRIE JONATHAN MICHAEL (US)
    Priority (No, Kind, Date): US 136920 A
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    Designated States: (National) AT; BE; CH; DE; FR; GB; IT; LI; LU; NL;
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    IPC:
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      C12N-015/00
    CA Abstract No: * 113(11)094353U
    Derwent WPI Acc No: * C 89-242804; C 98-129863; C 98-296758
    Language of Document: English
EUROPEAN PATENT OFFICE (EP)
 Legal Status (No, Type, Date, Code, Text):
                       19861023 EP AA
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                             US 922155 A
                                            19861023
    EP 265244
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                              (EUROPAEISCHE ANMELDUNG)
                             EP 87309308 A
                                              19871021
    EP 265244
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                       19880427 EP AK
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                                     (IN EINER ANMELDUNG OHNE
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                             RECHERCHENBERICHT BENANNTE VERTRAGSSTAATEN)
                                               PUBLICATION OF APPLICATION
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                       19880427 EP A2
                             WITHOUT SEARCH REPORT (VEROEFFENTLICHUNG DER
                             ANMELDUNG OHNE RECHERCHENBERICHT)
                       19890510 EP AK
    EP 265244
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                                              DESIGNATED CONTRACTING
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                             RECHERCHENBERICHT BENANNTE VERTRAGSSTAATEN)
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AT BE CH DE ES FR GB IT LI LU NL SE

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EP 265244	P	19891123 EP 17P REQUEST FOR EXAMINATION FILED (PRUEFUNGSANTRAG GESTELLT) 890912
EP 265244	P	(ERSTER PRUEFUNGSBESCHEID) 901227
EP 265244	P	19920923 EP AK DESIGNATED CONTRACTING STATES MENTIONED IN A PATENT SPECIFICATION ( IN EINER PATENTSCHRIFT ANGEFUEHRTE BENANNTE VERTRAGSSTAATEN) AT BE CH DE ES FR GB IT LI LU NL SE
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EP 265244	P	(IN AT EINGETRAGEN ALS:) AT 80949 R 19921015
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EP 328829	P	19871221 EP AA PRIORITY (PATENT
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EP 328829	P	(EUROPAEISCHE ANMELDUNG)
		FP 88312135 A 19881221
EP 328829	P	19890823 EP AK DESIGNATED CONTRACTING
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		AT BE CH DE FR GB IT LI LU NL SE
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22222	P	(ART. 93)) 19910123 EP 17P REQUEST FOR EXAMINATION
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		(IN AT EINGETRAGEN ALS:) AT 127854 R 19950915
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		BREVETTO EUROPEO)
	_	BARZANO' E ZANARDO ROMA S.P.A. 19951019 EP REF CORRESPONDS TO:
EP 328829	P	(ENTSPRICHT)
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EP 328829	P	19951229 EP ET FR: TRANSLATION FILED (FR:
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                              AT 19950913
JAPAN (JP)
  Patent (No, Kind, Date): JP 1211500 A2 19890824
   METHOD FOR TRAPPING TARGET AND BACKGROUND ACCOMPANIED BY AMPLIFICATION
      FOR AFFINITY ASSAY (English)
    Patent Assignee: AMOCO CORP
                         MAAKU REO KORINZU; DONARUDO NEIRU HARUBAATO;
           (Inventor):
      UORUTAA KINGU; JIYONASAN MAIKERU ROORII
    Priority (No, Kind, Date): US 136920 A
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                                             19881221
    Applic (No, Kind, Date): JP 88323183 A
    IPC: * C12Q-001/68; G01N-033/50; G01N-033/53
    Language of Document: Japanese
  Patent (No, Kind, Date): JP 63188399 A2 19880803
    TARGET FOR TESTING COMPATIBILITY AND BACKGROUND CATCHING METHOD AND
      APPARATUS (English)
    Patent Assignee: AMOCO CORP
    Author (Inventor): MAAKU REO KORINZU
    Priority (No, Kind, Date): US 922155 A
    Applic (No, Kind, Date): JP 87268030 A
                                             19871023
    IPC: * C12Q-001/68; C12M-001/34; G01N-033/50; C12N-015/00
    Language of Document: Japanese
  Patent (No, Kind, Date): JP 2817926 B2 19981030
    Priority (No, Kind, Date): US 135920 A Applic (No, Kind, Date): JP 88323183 A
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                                              19881221
    IPC: * C12Q-001/68; C12N-015/09; G01N-033/50; G01N-033/53
    CA Abstract No: * 113(11)094353U
    Derwent WPI Acc No: * C 89-242804; C 98-129863; C 98-296758
    Language of Document: Japanese
  Patent (No, Kind, Date): JP 2975603 B2 19991110
    Patent Assignee: BAISHISU INC
    Author (Inventor): MAAKU REO KORINZU
    Priority (No, Kind, Date): US 922155 A
                                              19861023
    Applic (No, Kind, Date): JP 87268030 A
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    IPC: * C12N-015/09; C12Q-001/68
    Language of Document: Japanese
UNITED STATES OF AMERICA (US)
                                           19980203
  Patent (No, Kind, Date): US 5714380 A
    CLOSED VESSEL FOR ISOLATING TARGET MOLECULES AND FOR PERFORMING
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AMPLIFICATION (English)

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Patent Assignee: AMOCO CORP (US)
  Author (Inventor): NERI BRUCE P (US); CURTIS JOHN S (GB); COLLINS
    MARK L (US); RYAN DANAHEY (US)
                                           19960325; US 400657 B1
   Priority (No, Kind, Date): US 622491 A
                            19940608; US 124826 B1 19930921; US 946749
     19950308; US 257469 B1
        19920917; US 648468 B1 19910131; US 644967 B2 19910122; US
     136920 B1 19871221; US 922155 B2 19861023
   Applic (No, Kind, Date): US 622491 A
                                         19960325
   National Class: * 435287200; 435287600; 435288500; 435288700;
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   IPC: * C12M-001/34; C12M-001/40
   CA Abstract No: * 109(11)089343D; 113(11)094353U
   Derwent WPI Acc No: * C 88-114361; C 89-242804; C 98-129863; C
     98-296758; C 98-129863
   Language of Document: English
 Patent (No, Kind, Date): US 5750338 A
                                        19980512
   TARGET AND BACKGROUND CAPTURE METHODS WITH AMPLIFICATION FOR AFFINITY
     ASSAYS (English)
   Patent Assignee: AMOCO CORP (US)
                                     (US); HALBERT DONALD N (US); KING
   Author (Inventor): COLLINS MARK L
     WALTER (US); LAWRIE JONATHAN M (US)
                                           19940503; US 124826 A
   Priority (No, Kind, Date): US 238080 A
                            19920917; US 648468 B1 19910131; US 922155
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   CA Abstract No: * 109(11)089343D; 113(11)094353U
   Derwent WPI Acc No: * C 88-114361; C 89-242804; C 98-129863; C
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   Language of Document: English
 Patent (No, Kind, Date): US 5780224 A
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   TARGET AND BACKGROUND CAPTURE METHODS AND APPARATUS FOR AFFINITY ASSAYS
     (English)
   Patent Assignee: AMOCO CORP (US)
   Author (Inventor): COLLINS MARK L' (US)
   Priority (No, Kind, Date): US 236877 A 19940429; US 6804
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                             19880115; HALBERT, DONALD N. : 19880115;
                             KING, WALTER: 19880115; LAWRIE, JONATHAN M.
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SOUTH AFRICA (ZA)
  Patent (No, Kind, Date): ZA 8707772 A
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    TARGET AND BACKGROUND CAPTURE METHODS AND APPARATUS FOR AFFINITY ASSAYS
      (English)
    Patent Assignee: AMOCO CORP
    Author (Inventor): COLLINS MARK LEO; MARK LEO COLLINS
    Priority (No, Kind, Date): US 922155 A 19861023
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